

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

SOR-36173

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on _____

Signature _____

Typed or printed name _____

Application Number

10/678,780

Filed

10/03/2003

First Named Inventor

Stephen SHEW

Art Unit

2616

Examiner

Mon Cheri S. DAVENPORT

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 32923
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

James M. Moore

Typed or printed name

216-579-1700

Telephone number

April 14, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney File No. SOR-36173			Date: April 14, 2008
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE			
In re application of:	Stephen SHEW et al.		
Serial No.:	10/678,780		
Filed:	October 3, 2003		
Title:	Call Control Using A Layered Call Model		
Group Art Unit:	2616		
Examiner:	DAVENPORT, Mon Cheri S.	Tel: (571) 273-8300	
Agent of Record:	James M. Moore	Reg. No. 32923	Tel: (216) 579-1700

Mail Stop AF

Commissioner for Patents
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Sir:

**ATTACHMENT TO FORM PTO/SB/33
REQUEST FOR PRE-APPEAL REVIEW**

Pursuant to 37 C.F.R. § 1.191, the Applicant has submitted a Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences, along with a Pre-Appeal Brief Request for Review. Specifically, the Applicant takes appeal from the Examiner's rejection of claims 1-15 under 35 U.S.C. §102(e). The Notice of Appeal has been filed in response to the Examiner's Final Action mailed November 15, 2007, and subsequent Advisory Action mailed February 15, 2008. In support of the above-noted Pre Appeal Brief Request for Review, the Applicant now submits the following arguments:

Applicant believes that the present request for Pre-Appeal Brief Review is appropriate, because of clear factual deficiencies in the rejections of record. More specifically, the Examiner has improperly refused to consider both the limitations of the claims and the arguments presented by the Applicant.

The Examiner's rejection

In the Final Action mailed November 15, 2007, the Examiner asserts (at page 2):

Regarding Claim 1 Charas et al. discloses a method of controlling a multi-layer transport network, the method comprising steps of (see figure 2A, section 100, *access network*):

determining whether a connection (*mapping packets*) supporting a performance requirement of a call can be established within a first layer of the network (see col. 4, line 39-41, *packets are connected to layer one of the network if predetermined criteria is met*) ; and

if the connection cannot be established, defining an association between the call and a second call (reads on second attempt to establish connection) (see col. 4, line 51-54, *the access router functions as a service access node and associates access function of services required*) instantiated within a respective second layer of the network (see col. 4, line 39-41, *connection is established in the bearer (layer) when predetermine criteria is met*).

In Applicant's response filed August 27, 2007, Applicant provided a detailed explanation of the terms used in the claims, as these terms would be understood by a person of ordinary skill in the art, in view of the teaching of the specification. However, in the Final Action mailed November 15, 2007, the Examiner dismissed these arguments as follows:

- At section 4 of the Detailed Action, the Examiner refers to Applicants comment that Charas et al are silent with respect to the transport or control of traffic with the networks 118, and asserts that this "argument does not pertain to claims as presented".

- At Section 5 of the Detailed Action, the Examiner states that “the recitation ‘multilayer transport network’ has not been given patentable weight because the recitation occurs in the preamble.”
- Page 7, 1st paragraph of the Detailed Action states, with reference to the terms “call” and “connection”: “The Examiner has given the broadest interpretation of claim terms as presented”

Applicant’s response mailed January 15, 2008 contained a detailed rebuttal of all three of these points.

In the Advisory Action mailed February 15, 2008, the Examiner dismissed the Applicant’s arguments as non-persuasive. With respect to the first two items above (referring to the transport or control of traffic in Charas’ networks 118, and the limitations to the multi-layer transport network), the Examiner effectively repeated the statements provided in the Final Action. The Advisory action did not address Applicants arguments with reference to the terms “call” and “connection”, and thus it appears that the Examiner has conceded this point..

Applicant contends that the Examiner’s arguments, as set out in the Final Action mailed November 15, 2007 and Advisory Action mailed February 15, 2008 improperly fail to consider limitations of the claims, and applicant’s arguments, and further denies the Applicant a reasonable opportunity to adequately respond to the Examiner’s rejections.

With specific reference to the transport or control of traffic in the network, the Examiner has asserted that Applicant’s arguments are non-persuasive because Applicant’s “argument does not specifically address claim limitations against Examiner’s rejection of claim limitations” [see Advisory Action]

However, Applicant is not aware of any provisions of the 35 U.S.C., 37 C.F.R. or MPEP that requires Applicant to “specifically address claim limitations against Examiner’s rejection of claim limitations”. On the other hand, “USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead,

the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981)” [MPEP 2106(II)]

As such, rejection of specific claim elements in isolation from one another is improper, and Applicant believes that they are entitled to address the claimed invention as whole, and to discuss the differences between the claimed invention, as a whole, and the teaching of the cited reference(s). In that respect, Applicant has repeatedly argued that Charas et al teaches methods and systems for conveying data packets through a radio link in an access network; whereas the present invention is directed to a method of controlling a multi-layer transport network. Applicant’s comment that Charas et al are silent with respect to the transport or control of traffic within the ATM/PSTN/IP networks 118 also serves to emphasize this point, since the person of ordinary skill in the art will recognise that the ATM/PSTN/IP networks 118 of Charas et al. are transport networks. Applicant further believes that this position is intimately and directly pertinent to the claims as presented.

With specific reference to the claim limitation to the multi-layer transport network defined in the preamble, the Examiner has asserted that the multi-layer transport network does not need to be treated as a structural limitation of the claim, because “Charas et al reads on claim limitations as presented.” (see Advisory Action).

However, “Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) [MPEP 2111.02(I)]. Applicant is not aware of any provision of the MPEP that permits a structural limitation of a claim to be ignored, on the basis that (by virtue of ignoring that structural limitation) the remaining elements of the claim might allegedly read onto the prior art.

Furthermore, Applicant notes that the Examiner has apparently conceded that the terms “call” and “connection” appearing in the claims must properly be given their broadest reasonable interpretation consistent with the specification [MPEP 2111], and that this interpretation must necessarily be consistent (or, at the very least, not inconsistent) with the communications standards explicitly enumerated in the specification. Clearly, Charas et al. do

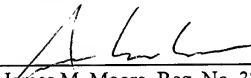
not teach, suggest, or even remotely contemplate anything remotely similar to the “calls” and “connections” defined in the claims, when those terms are properly given their broadest reasonable interpretation consistent with the specification. As such, it is clear that elements of claim 1 in fact do not read onto the teaching of Charas et al.

In light of the foregoing, it is submitted that the Examiner's claim rejections are entirely lacking proper factual basis, wherefore Pre-Appeal panel review of this case is believed to be appropriate, and early action in that respect is courteously solicited.

If any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this response, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 16-0820.

Respectfully submitted,

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